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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

00-030

Application Number

09/855,300

Filed

May 15, 2001

First Named Inventor

WALKER, Jay S.

Art Unit

3622

Examiner

VAN BRAMER, John W.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 33,384

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34

  
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October 27, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Re: Application No. **09/855,300**Customer No. **22927**

Examiner: VAN BRAMER, John W.

Confirmation No. **8793**

### REMARKS AND ARGUMENTS

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Final Office Action mailed June 30, 2006 (the "Final Office Action"). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

#### **A. Status of Claims**

Claims **1-43** are pending in the application, and claims **1, 20 and 38-43** are independent claims.

Claims **1-37** stand rejected under 35 U.S.C. §101, claims **38 and 39** stand rejected under 35 U.S.C. §112, claims **1, 2, 10-13, 20, 21, 23, 30, 31 and 35-43** stand rejected under 35 U.S.C. §102(b), and claims **3-9, 14-19, 22, 24-29 and 32-34** stand rejected under 35 U.S.C. §103(a).

#### **B. Claim Rejections Under 35 U.S.C. §101**

The Examiner maintains that claims **1-37** are drawn to non-statutory subject matter. The Supreme Court has "... recognized limits to §101 and every discovery is not embraced within the statutory terms. Excluded from such patent protection are laws of nature, physical phenomena and abstract ideas." *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981). We respectfully assert that claims **1-37** do not fit into one of the excluded categories.

Claim **1** recites a billing statement comprising a description of a transaction, and *an offer pointer associated with the transaction, wherein the offer pointer comprises information for use to review an offer*. An offer pointer may be a toll-free telephone number or hyperlink, for example, positioned adjacent the transaction, and an offer pointer may be customized based on details of the transaction. Such a billing statement is advantageous because the offers can be tailored to the consumer, and because complex details of the offer can be provided elsewhere which conserves space on the billing statement (See specification, page 4, line 28 to page 5, line 14). Similarly, claim **20** includes a description of a

transaction, and *an offer associated with the transaction, wherein the offer is an offer to reduce an amount owed associated with the transaction.* Such billing statements are not mere compilations of data, but are articles of manufacture that include the novel feature of an offer pointer associated with a transaction, or a specific type of offer associated with a transaction.

In support of this §101 rejection, the Office Action of 12/06/2005 recited:

“The claimed billing statement is merely a document containing information, presumably about a monetary amount owed by a receiving party. Therefore, none of the claims include any functional language describing actions to be taken nor procedures to be followed in order to produce the invention, and thus are considered non-functional descriptive material.” (Office Action of 12/06/2005, page 3)

The argument thus seems to be that the “descriptive material” will not distinguish the claimed invention from the prior art in terms of patentability. But the Federal Circuit stated:

“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. In other words, printed matter of a claim will not be given patentable weight if the printed matter is not functionally related to the substrate on which it is printed.” *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1994)

In the present case, the differences between independent claims **1 and 20** and the prior art reside in the functionality of the printed matter, and therefore: “...cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.” *Id.* As the Federal Circuit made clear in *Gulack*, it must first be determined whether the printed matter is functionally related to the substrate. If it is, it must be given patentable weight. In *Gulack*, the Federal Circuit reversed the rejection of the claims under §103 because it found that the printed matter in question was functionally related to the substrate and because the prior art failed to disclose or suggest the printed matter claimed.

Claims **1 and 20** each include limitations that distinguish over the cited art (explained in detail below). Accordingly, for at least the reasons set forth above, we assert that claims **1 -37** recite statutory subject matter and therefore that the 35 U.S.C. §101 rejection should be withdrawn.

### C. Claim Rejection Under 35 U.S.C. §112, First Paragraph

Claims **38** and **39** stand rejected for allegedly being non-enabling. These two claims were previously rejected as being “single-step” process claims, and were amended in our prior response. Pending claim **38** (which is illustrative of both claims) recites a method that includes *generating a billing statement and determining an offer pointer associated with the transaction, wherein the offer pointer includes information for use to review an offer*. The Examiner’s rationale for maintaining the §112 rejection is that claims **38 and 39**:

“... do not enable any person skilled in the art... to determine the step or steps needed to arrive at the invention commensurate in scope with the claims.” (Final Office Action, page 2, paragraph 3)

We disagree. It is readily apparent that one skilled in the art of billing statements, upon reading either of claims **38 and 39**, would indeed be able to perform the process set forth therein. Accordingly, we submit that the rejection of Claims **38 and 39** under 35 U.S.C. §112 cannot stand.

### D. Claim Rejections Under 35 U.S.C. §102(b)

Claims **1, 2, 10-13, 20, 21, 23, 30, 31, 35-43** stand rejected for allegedly being anticipated by page 331 of Carson et al., “*College Accounting, Eighth Edition*” (hereinafter “Carson”).

Carson illustrates a monthly “Statement of Consignment Sales” from “Mattoon Electric Co.” to “Windsor Hardware Co.”. It includes a previously forwarded balance amount (in line 1 of \$348.92), and a list of charges or credits (see list under line 2) that totals \$146.94. When these two amounts are added, they total \$495.86 (the “total accountability” amount of line 3). Various other charges are either added or subtracted from this “total accountability” amount to arrive at a net amount of \$115.57 (line 9). An explanation of the “special compensation” appears at the bottom, and a discount on the net amount is automatically included if the Agent simply sends his check for payment by the seventh day of each month.

We reassert that Carson does not disclose the claimed offer pointer. As noted above, claim **1** includes that *the offer pointer comprises information for use to review an offer*. In addition, independent claims **38, 40 and 41** recite *determining an offer pointer* that is either associated with, or based on, the transaction. In stark contrast, Carson merely shows a statement of charges and credits and an amount due for remittance. The two percent discount (for paying the bill on time) is different from the claimed offer pointer, because the discount is a static announcement associated with the billing statement as a whole. Thus,

Carson does not teach or suggest the claimed billing statement having an offer pointer *associated with a transaction*, wherein the *offer pointer comprises information for use to review an offer*. Furthermore, Carson does not teach or suggest *determining an offer pointer associated with a transaction, for use to review an offer* recited by claims **38, 40 and 41**.

The Examiner argues that Carson contains offer pointers such as “See Note Below” and “(-)” (Final Office Action, page 9, paragraph b.) But as explained above, these are static indicia associated with the billing statement as a whole, and thus are not comparable to the offer pointer recited by claims **1, 38, 40 and 41**.

Similarly, independent Claims **20** and **39** recite that the offer comprises *an offer to reduce the amount owed associated with the transaction*. Carson fails to teach or suggest this feature, as the “See Note Below” phrase relied upon (Final Office Action, page 10, paragraph c) is associated with the billing statement as a whole and not with a transaction.

Claim **42** recites *receiving from a customer an offer pointer associated with a transaction*, and then *transmitting an offer to the customer that is associated with the offer pointer*; and Claim **43** recites *receiving a request from a customer to review an offer pointer associated with a transaction...*, and then *transmitting the offer to the customer, and determining a new amount owed by the customer if the offer is accepted by the customer*. Carson fails to teach (or even suggest) such processes.

Accordingly, independent claims **1, 20 and 38-43**, and dependent claims **2, 10-13, 21, 23, 30, 31 and 35-37** (which all directly or indirectly depend on either of claims **1** or **20**), are not anticipated by Carson. Thus, the 35 U.S.C. §102(b) rejections cannot stand.

#### **E. Claim Rejections Under 35 U.S.C. §103(a)**

Dependent Claims **3-9, 14-19, 22, 24-29 and 32-34** stand rejected for allegedly being unpatentable over Carson.

Claims **1** and **20** are patentably distinct over Carson for at least the reasons recited above. Since claims **3-9, 14-19, 22, 24-29 and 32-34** all directly or indirectly depend from claims **1** and **20**, these claims should be allowable for at least the same reasons. Also, a *prima facie* case of obviousness has not been made for any claim in light of Carson. The Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence in support of such a finding, which are both necessary to assess obviousness. See M.P.E.P. §2141.03.

Furthermore, no *prima facie* case of obviousness has been established for claims **3-9, 14-19, 22, 24-29 and 32-34** in light of Carson, because no substantial evidence has been made of record to support the various “Official Notice” assertions of the Examiner. No evidence was offered to show:

- a) That it is old and well known to present billing and other financial information as viewable electronic data (Final Office Action, page 5, with regard to claims **3** and **22**);
- b) That it would have been obvious to one of skill in the art that the offer pointer would comprise “appropriate instructions” based on the method by which the customer is to receive an offer (Final Office Action, page 6, with regard to claims **4-9** and **24-29**);
- c) That it would have been obvious to one of skill in the art to provide the same or different terms for each transaction listed on Carson (Final Office Action, page 7, with regard to claims **17** and **32**);
- d) That Carson discloses that the second offer is the same as the first offer (Final Office Action, page 8, with regard to claims **18** and **33**);
- e) That it is a “design choice” to place an offer pointer adjacent to a description of a transaction on the billing statement (Final Office Action, page 8, with regard to claims **19** and **34**).

The Section 103(a) rejections in light of Carson and either “Official Notice”, or some other undefined criteria for what is considered to be “known” in the art, cannot stand because these obviousness rejections are not supported with substantial evidence of any motivation to combine Carson with anything else, in a manner that provides for all of the cited features of any claim.

## **F. Conclusion**

In view of the above remarks, we respectfully request review and reversal of all of the Section 101, 112, 102(b) and 103(a) rejections of the pending claims.

Respectfully submitted,

October 27, 2006  
Date

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